

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Joseph BACH	Group Art Unit: 3629
APPLN. NO. 09/327,085	Examiner: VIG, Naresh
FILED: June 4, 1999	February 17, 2003
ENTITLED: SYSTEM AND METHOD FOR SOLICITING AND RECEIVING MERCHANDISE ORDERS	Morgan Hill, California

SUPPLEMENTAL APPEAL BRIEF PURSUANT TO

NOTICE OF

REINSTATEMENT OF APPEAL REQUESTED UNDER 37 CFR § 1.193(B)(2)(ii)

Box AF
Commissioner for Patents
Washington, D.C. 20231

Board of Patent Appeals and Interferences:

This Supplemental Appeal Brief is filed pursuant to a request for reinstatement of appeal filed herewith, which is filed in response to the Examiner's Final Rejection mailed on December 15, 2005, following Appellant's Appeal Brief filed on February 24, 2003.¹ No Examiner's Answer has been filed during the 3 years period from Appellant's filing of the Appeal Brief and the Examiner's issuance of the pending Final Office Action. This Supplemental Appeal Brief addresses the new issues raised in the pending Final Office Action and carries over points made in the original Appeal Brief.

Since Appellant elected to request reinstatement of the appeal after prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) should be applied to the subject appeal and, therefore, no fees are required under § 1.17(f). Appellant hereby petitions for any extension of time that may be required to keep this Application pending.

This Supplemental Brief is transmitted in triplicate.

(1) Real Party in Interest

The real party in interest of the present application is the Appellant, Joseph Bach.

¹The pending Office Action contains no indication or statement that prosecution has been reopened by the Examiner; however, this is assumed to be the case.

(2) Related Appeals and Interferences

None.

(3) Status of Claims

Claims 1, 2, 5 and 6 are presently pending in this Application. Claims 1, 2, 5 and 6 are finally rejected by the Examiner. Claims 10 and 12 were previously canceled by an Amendment After Final.

(4) Status of Amendments

An Appeal Brief was filed on February 24, 2003. No Examiner's Answer has been filed. Instead, a Final Office Action has been issued on December 15, 2005, stating no new rejections on the merit, but rather raising new issues under 35 U.S.C. § 101 and § 112. An attempt to resolve these issues has been made during several telephonic conferences with the Examiner's supervisor; however, no agreement has been reached. No new Amendments are being proposed, and the Advisory Action dated 1/16/2003 indicates that the amendment filed September 24, 2002 will be entered.

(5) Summary of the Invention [As stated in the original Appeal Brief]

The present invention relates to a system enabling the placing of orders for merchandise (§ 0001, note: references made herein relate to the substitute specification filed on May 13, 2002, and never objected to by the Examiner in any subsequent communications). The system is generally a home audio receiver that receives and plays audio programs (§ 0006). The audio receiver further includes a rider buffer that receives and stores a rider signal from the transmitted audio program (§ 0006). That is, for an implementation of the invention, the transmission of audio program also includes a transmission of a rider signal which includes various information relating to the audio program (§ 0006). For example, when the audio program is a song, the rider signal may include the song, artist, and album names (§ 0006). The audio player may also include an ordering memory, for storing information relating to the user, such as mailing address, billing address, etc. (§ 0006).

When the user hears a song he/she would like to order, the user may press the "order" button on the user interface (§ 0007). When the audio player receives the "order" signal, it establishes a line of communication to an ordering center via the phone system (§ 0007). When the line of communication is established, the audio system fetches the information from the rider buffer and, optionally, from the order memory, and places an order for the song that was playing when the "order" button was pressed (§ 0007).

An illustrative system is depicted in Figure 1, and is reproduced here for convenience. A

programming signal and a corresponding rider signal are received via the I/O interface 100 (§ 0015). The main program 200 sends the program signal to the audio player 300, and the rider signal to the rider buffer 400 (§ 0015). When a user hears a particular song the user may wish to purchase, the user may place an order using the user interface 500 (§ 0017). If that happens, ordering interrupt 600 establishes communication line with the ordering center and places an order corresponding to the information in the rider buffer 400 (§ 0017).

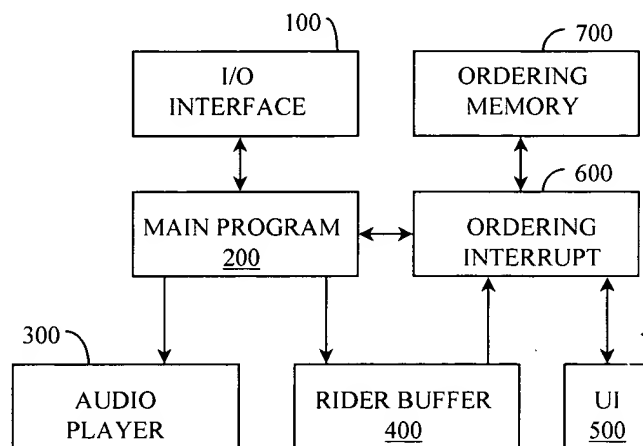


FIGURE 1

(6) Issues

In addition to the patentability issue which is carried over from the original Final Office Action and stated in (iii) below, two more issues were raised by the Examiner for the first time in the current Final Office Action, as presented in (i) and (ii) below to the Board of Appeals for review:

- (i) Whether claims 1, 2, 5 and 6 are unpatentable under 35 U.S.C. §101 as being directed to non-statutory subject matter.
- (ii) Whether claims 1, 2, 5 and 6 are unpatentable under 35 U.S.C. §112, Second Paragraph, as being indefinite.
- (iii) Whether claims 1, 2, 5 and 6 are unpatentable under 35 U.S.C. §103(a) as being made obvious by U.S. Patent 6,389,055 to August (hereinafter August), in view of U.S. Patent 5,303,393 to Noreen (hereinafter Noreen).
- (iv) An ancillary procedural issue is whether the Examiner was justified in making the subject Office Action Final.

(7) Grouping of claims

Each of claims 2, 5, and 6 stands or falls together with independent claim 1.

(8) Argument

Each of claims 1, 2, 5 and 6 are improperly rejected and are allowable for at least the reasons set forth below. Appellant respectfully requests reversal of all grounds of rejection set forth by the Examiner.

(A) 35 USC 101 rejection of claims 1, 2, 5 and 6

Preliminary, Appellant notes that while the Examiner stated: “claims 1-4 are rejected under 35 USC § 101 ...,” claims 3 and 4 are not pending in this application. Therefore, Appellant assumes, and requests the Board to consider, that this rejection is directed at claims 1, 2, 5 and 6.

The Examiner has finally rejected (presumably all of) the pending claims for allegedly attempt to “embrace or overlap two different statutory classes of invention...” The Examiner cites *Ex Parte Lyell* (17 USPQ2d 1548) in support of this rejection. Appellant respectfully submits that the Examiner misapplied the holding of *Ex Parte Lyell* and that the subject claims do not fall within the holding of *Ex Parte Lyell* and do fully comply with the statutory requirements of 35 USC 101.

As stated in MPEP 2173.05(p)(II), a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph, and such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine." However, the pending claims are clearly directed at an apparatus exclusively, and no method for using the apparatus is recited within any of the pending claims. While in holding this rejection the Examiner stated that the preamble of claim 1 recites a system [i.e., an apparatus], and that the body of the claim “discusses the specifics of method (the steps) executed by the interactive audio system,” this is clearly not the case. The preamble of claim 1 recites a system (an apparatus) and the body of the claim sets out the various parts of the system and their interrelation. Appellant respectfully submits that Claim 1 is clearly directed at an apparatus and no method or steps are recited therein.

In *Ex Parte Lyell* the claim at issue recited:

“2. An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,

and [sic] internally splined sleeve affixed upright to said support means,

a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,

and further comprising the steps of

1. positioning the output end of an automatic transmission onto said upright sleeve,
2. removing the internal components of said automatic transmission from the casing of said transmission,
3. repairing and replacing said internal components back into said casing, and
4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.” (Emphasis added)

As can be readily seen, in *Ex Parte Lyell* the applicant clearly intended to claim both an apparatus and a method for using the apparatus in a single claim. In fact, applicant Lyell argued that “the apparatus and method involved in the present application are “inextricably related.” *Id.* In this respect, the Board was concerned that a potential manufacturer of the apparatus would have no adequate notice of the claim’s scope, as the maker of a device having the same structure as claimed may be held hostage to infringing use of a potential buyer of the device, should the buyer use the apparatus in a manner infringing the claimed method. See also IPXL Holdings, L.L.C., v. AMAZON.COM, INC., 430 F.3d 1377 (2005).

In contrast, in the claims currently before the Board, no attempt is being made to claim both an apparatus and a method for using the apparatus. To the contrary, Appellant clearly intends to claim, and the claims explicitly recite, an apparatus only. No method limitations are present in any of the claims before the Board. Furthermore, Appellant respectfully submits that the language of the claim clearly provides a notice to a maker of such a system with respect to the metes and bounds of the claim. Whether a device manufactured according to the apparatus limitations of claim 1 infringes the claim does not depend on the manner in which a purchaser may operate the system. It is clear from the face of the claim what elements in the system would contribute to infringement of the claim, without reference to a user’s method of operation of the system.

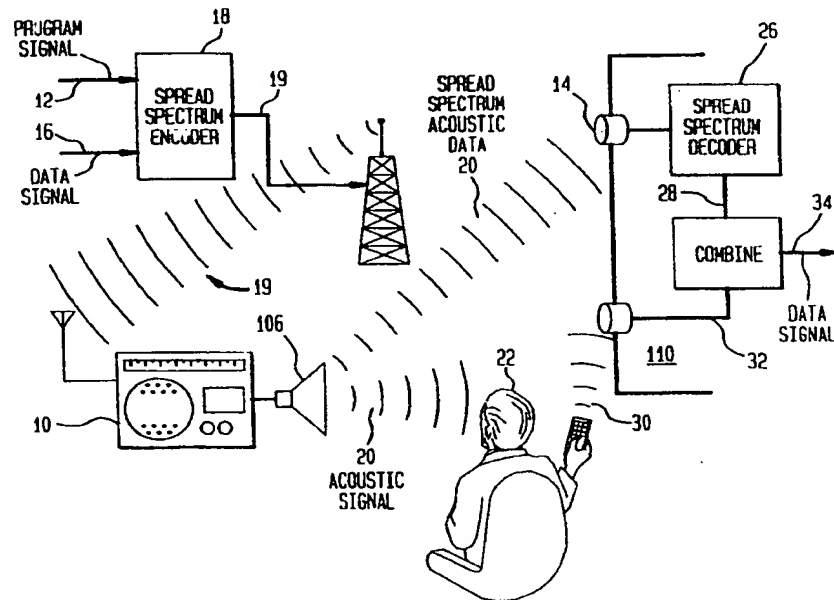
(B) 35 USC 112, Second Paragraph, rejection of claims 1, 2, 5 and 6

The Examiner rejected claim 1, 2, 5, and 6 under 35 USC 112, Second Paragraph, as being indefinite. As with the 35 USC 101 rejection, the Examiner takes the position that the claim is directed to a system, but the body of the claim recites the specifics of a method executed by the system. Appellant respectfully submits that this rejection stems from the Examiner’s misreading of *Ex Parte Lyell* and the Examiner’s distorted reading of Appellant’s claims. Appellant respectfully submits that claim 1 is directed at an audio system (an apparatus) and the body of the claim recites its various elements and their function and interrelation. As explained with respect to the 35 USC 101 rejection above, Appellant respectfully submits that the claims as currently pending are definite and are clearly within the provisions of 35 USC 112, Second Paragraph.

(C) 35 USC 103(a) rejection of claim 1 [As stated in the original Appeal Brief]

For the most part, the Examiner relies on August in making the rejection. Appellant respectfully submits that August, independently or in combination with Noreen or any other prior art of record, fails to disclose, suggest, or make obvious the claimed invention. For the Board's convenience, Figure 1 of August is reproduced herein-below.

FIGURE 1 OF USP 6,389,055



With reference to column 2, line 66, to column 3, line 43, of August, a program signal 12 and a data (rider) signal 16 are combined by the spread spectrum encoder 18 and are transmitted as a combined broadcast signal 19. A conventional monitor 10, such as a radio or TV, receives the combined signal and plays the combined signal. That is, the data signal is encoded into the program signal "such that the effect on audio signal 20 is imperceptible, or at least unobjectionable" (cl. 3, ln. 12-14). A separate capture device 110 utilizes a microphone 14 to receive the combined signal as reproduced by the loudspeaker 106. The output of microphone 14 is sent to a spread spectrum decoder 26, which "is only sensitive to the digital data encoded onto the audio signal by the spread spectrum encoder 18" (cl. 3, ln. 39-41). The captured data may be stored "for future use or to initiate a transaction with a seller of goods" (cl. 3, ln. 26-28).

As can be understood from August's disclosure and from the above reproduced Figure 1, August

teaches the use of a conventional (unmodified) audio/video device (monitors 10 and 105) to reproduce the incoming program and data signals as combined audio signal 20. That is, contrary to the claimed invention, August teaches not to separate the rider signal from the program signal prior to providing the audio signal. Rather, August teaches to maintain them together and send both of them to the audio player, relying on the encoding to provide a combined signal that is imperceptible or unobjectionable to the listener. August provides a separate device, spread spectrum decoder 26, to receive only the rider signal and store it for future transactions. The Examiner failed to provide any indication or reasoning of how any other prior art may be utilized to remedy this deficiency - in effect, teaching to the contrary - of August.

More specific to the claim language, Appellant respectfully submits that August fails to disclose or suggest the limitation:

“a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer;”

That is, according to the claimed invention, a main processor of the audio system receives a signal that includes both the programming signal and the rider signal. This main processor then sends the program signal to the audio player and stores the remaining rider signal in a rider buffer of the audio system. Such an apparatus is not disclosed nor suggested by the combined prior art.

In August, for example, a receiver, such as a radio or a television, receives the program signal and the rider signal and plays both signals. The receiver does not separate the signals, does not store the rider signal in a rider buffer – nor is there a suggestion or a motivation to do so as August discloses a capture device 110 for that purpose. Therefore, August clearly fails to disclose or suggest the limitation “directing said programming signal to the audio player and storing the rider signal in the rider buffer;” as August discloses directing both the program signal and the rider signal to the audio player and fails to disclose storing the rider in a rider buffer.

On the other hand, August discloses a “capture device” that captures the rider signal. However, even if one considers the capture device to correspond to the claimed “main processor,” it still fails to disclose or suggest the quoted limitation. That is, August’s capture device fails to disclose or suggest the limitation “directing said programming signal to the audio player,” because in August the programming signal has already been played and perceived by the user. Again, the Examiner failed to provide any indication as to how August combined with Noreen make this limitation obvious.

Thus, as can be seen, the claimed limitation to “main processor” is not disclosed nor suggested by August. If one argues that August’s receiver 10 is the main processor, then August’s “main processor” fails to store the rider signal on a rider buffer, but rather plays the rider signal on the audio player. If one argues that August’s capture device 110 is the main processor, then August’s “main processor” fails to send the programming signal to the audio player. Even if one takes the entire system of August to be the claimed Audio system, still there’s no disclosure or suggestion for an element that corresponds to the claimed “main processor.” That is, there’s no teaching or suggestion for an element that receives the combined signal, sends the program signal to the audio player, and sends the rider signal to a memory.

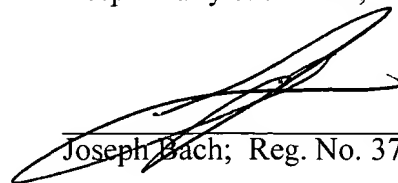
(D) Finality of the subject Office Action

The subject Office Action has been issued three years after Appellant’s filing of his Appeal Brief, with the Examiner failing to file an Examiner Answer and failing to indicate that prosecution is reopened. The subject Office Action contains art rejection that is based on the same prior art and same reasoning used in the previous Final Office Action. However, the current Office Action contains two new rejections based on 35 USC 101 and 112, Second Paragraph, neither one of which triggered by Appellant’s action. Rather, Appellant respectfully submits that these rejections could have been raised in the previous office action issued prior to the original filing of the Notice of Appeal. Appellant respectfully submits that to issue these rejections three years after Appellant’s filing of an Appeal Brief and to make the rejections final is reprehensible. Appellant was never given the opportunity to respond to these rejection and any attempt by Appellant to amend the claims in view of these rejections may now be met with a refusal of entry. Accordingly, Appellant respectfully submits that the Examiner was not justified in making the subject rejections final.

Conclusion

It is believed that all rejections made by the Examiner have been addressed and overcome by the above arguments. Therefore, it is respectfully submitted that all of the pending claims are allowable. Accordingly, a reversal of all the pending rejections is respectfully requested.

Respectfully submitted,



Joseph Bach; Reg. No. 37,771

Dated: March 6, 2006

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(9) Appendix of Pending Claims

1. An interactive audio system, comprising:
 - a home audio system having a user interface;
 - a communication device connecting said home audio system to a telephone;
 - an audio player receiving music signal and audibly playing music pieces from said music signal;
 - a rider buffer storing data corresponding to said music pieces;
 - a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer;
 - an ordering interrupter;
 - wherein upon receiving a command from the user interface, said ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places an order for a hard copy of the music piece corresponding to the data stored in said rider buffer.
2. The system of claim 1, further comprising an ordering memory having ordering data stored therein.
5. The system of claim 1, wherein said communication device comprises a cellular phone.
6. The system of claim 1, wherein said communication device comprises a modem.



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In re the Application of: Joseph BACH

APPLN. NO. 09/327,085

Group Art Unit: 3629

FILED: June 4, 1999

Examiner: VIG, Naresh

ENTITLED: SYSTEM AND METHOD FOR SOLICITING
AND RECEIVING MERCHANDISE ORDERS

NOTICE OFREINSTATEMENT OF APPEAL UNDER 37 CFR § 1.193(B) (2) (ii)**Box Appeal**

Commissioner of Patents
Washington, D.C. 20231

Sir:

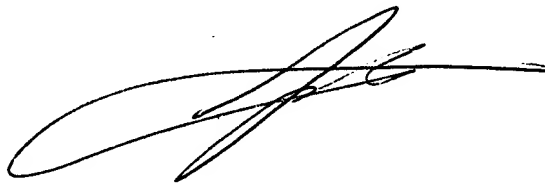
Applicant requests a reinstatement of appeal in response to the Examiner's Final Rejection mailed on December 15, 2005, following Appellant's Appeal Brief filed on February 24, 2003.¹ No Examiner's Answer has been filed during the 3 years period from Appellant's filing of the Appeal Brief and the Examiner's issuance of the pending Final Office Action. Appellant also submits herewith a Supplemental Appeal Brief addressing the new issues raised in the pending Final Office Action.

Since Appellant elected to request reinstatement of the appeal after prosecution was reopened prior to a decision on

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the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) should be applied to the subject appeal and, therefore, no fees are required under § 1.17(f). Appellant hereby petitions for any extension of time that may be required to keep this Application pending.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Joseph Bach', with a large, sweeping loop on the left side.

Joseph Bach
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Date: March 6, 2006